

Status of the Claims

Claims 1, 3, 8, 10-13, 15, 16, 20, 22, 23, 25, 26, 36, 43, and 59-70 are pending.

The Rejections

Claims 1, 3, 8, 10-13, 15, 16, 20, 22-23, 25-26, 36, 43, 59, and 60-65 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswamy et al. (U.S. 6,261,613) in view of Ray et al. (U.S. 6,004,595) and Gulstad et al. (U.S. 3,767,421).

Claim 66 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswamy et al. in view of Ray et al. and Gulstad et al. as applied to claims 1, 3, 8, 10-13, 15, 16, 20, 22-23, 25-26, 36, 43, 59, and 60-65 further in view of Schaible et al. (U.S. 6,365,210).

Claim 67-70 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswamy et al. in view of Ray et al. and Gulstad et al. as applied to claims 1, 3, 8, 10-13, 15, 16, 20, 22-23, 25-26, 36, 43, 59, and 60-65 further in view of Rea (U.S. 6,053,400) and Lonergan et al (U.S. 5,672,369).

Remarks

The present invention claims a packaged dough product that has at least two individual (i.e., discrete) portions of a chemically leavened dough product in a low pressure (preferably non-pressurized) container. The dough composition employed in the present invention inhibits leavening or expansion during processing and refrigerated storage and eliminates the use of pressurized packaging. The dough composition comprises, *inter alia*, **an encapsulated** basic active ingredient and **a non-encapsulated** acidic active ingredient. The acidic active ingredient has a solubility of greater than 35 kcal/mole in the dough below baking temperature.

Discussion

The following remarks are directed to the rejection of claim 1 under 35 U.S.C. 103(a). However, the Applicant submits that the rejection of this claim, and therefore the rejection of all of the remaining claims, is improper.

The Examiner has maintained her previous rejection of claim 1, essentially without change. The Examiner continues to argue that Narayanaswamy and Gulstad references disclose the same leavening acid as is required by the present invention and that Gulstad further discloses that some leavening acids are slower than others. The Examiner states that Narayanaswamy discloses acidic leavening agents that include sodium aluminum phosphate and sodium acid pyrophosphate. She concludes that it would thus be obvious that the leavening agent has the solubility claimed. This is an improper expansion of the disclosure of Narayanaswamy.

First, it is noted that both Narayanaswamy and Gulstad disclose the same three acidic leavening agents. These are sodium aluminum phosphate (SALP), sodium acid pyrophosphate (SAPP) and monocalcium phosphate (MCP). The solubility values of these acidic leavening agents are:

SALP 37.7 kcal/mole

SAPP 27.5 kcal/mole/33.7 kcal/mole

MCP 16.8 kcal/mole.

Thus, of the three acidic leavening agents disclosed in the references, only one has a solubility value that meets the solubility limitation required in the claims. The others have solubility values that are outside of the scope of the claims. Thus, contrary to the Examiner's position, Narayanaswamy does not make it obvious that the active ingredient of the present claims must have the solubility as claimed. In fact neither Narayanaswamy nor Gulstad make it obvious that the acidic active ingredient must have a solubility of greater than 35 kcal/mole.

The determination of obviousness under 35 U.S.C. 103(a) is a legal conclusion based upon factual evidence. See *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007). In KSR, the Supreme Court said that determination of obviousness depends upon (1) the scope and content of the prior art; (2) the

differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) an evaluation of any relevant secondary consideration. (See *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1996.))

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole. This includes a consideration of the particular problem solved by the elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Moreover, the Examiner must avoid hindsight. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. See *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

The Court in *KSR* reaffirmed that hindsight reasoning is improper by stating that “[a] fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

As discussed above, neither Narayanaswamy nor Gulstad discloses, either alone or in combination, all of the elements of claim 1. That is, neither discloses that the acidic active ingredient must have a solubility of at least 35 kcal/mole. Rather, each of these references suggests that an acidic active ingredient whose solubility is less than the required minimum value should be employed. Accordingly, neither of these references render either claim 1, or any claim dependent therefrom, unpatentable under 35 U.S.C. 103(a).

Conclusion

In view of the preceding discussion, it is respectfully submitted that the claims of the above-identified application are now in condition for allowance. Reconsideration of the rejections and favorable action are requested. The Examiner is invited to contact the undersigned, at the Examiner’s convenience, should the Examiner have any questions regarding this communication or the present patent application.

Respectfully Submitted,

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